

**REMARKS**

**I. Status of the Claims**

Claims 11 - 100 are now pending in this application. Claims 43-99 have been withdrawn from consideration. Claims 11-42 and 100 have been examined. Claim 100 has been amended.

Claim 100 has been amended to delete "of the formula" as suggested by the Examiner. Accordingly, no new matter has been added by this amendment nor does this amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action. The proposed amendment, moreover, places the claims in condition for allowance or, at least, in better form for appeal, if necessary.

**II. Rejection under 35 U.S.C. § 112, second paragraph**

Claim 100 is rejected under 35 U.S.C. § 112, as allegedly being indefinite. *Office Action* at p. 2. Applicants respectfully traverse this rejection.

The Examiner believes that "of the formula" renders claim 100 unclear. *Id.* at p. 3. Although Applicants respectfully disagree, claim 100 has been amended to delete "of the formula." It is believed that this amendment in no way narrows the scope of claim 100.

Accordingly, Applicants respectfully request withdrawal of this rejection.

**III. Rejections under 35 U.S.C. § 102**

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587

(CCPA 1972); see also M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly."). Importantly, each and every element of a claim must be set forth in the prior art reference for there to be anticipation. See M.P.E.P. § 2131.

A. Yarovenko

1. Claim 100 is rejected under 35 U.S.C. § 102(b) as being anticipated by Yarovenko et al. (DN 73:34993, CAPLUS, abstract of Zh. Org. Khim. (1970), 6(5), 947-9). *11/11/02 Office Action* at p. 3.

Claim 100 has been amended to replace "imino(phenylamino)methane-sulphinic acid" with (carboxymethylamino)iminomethanesulphinic acid. Support for this compound can be found in claim 100 as originally filed. Because Yarovenko et al. does not disclose "(carboxymethylamino)iminomethanesulphinic acid," Applicants believe that claim 100 is patentable over Yarovenko.

Accordingly, Applicants respectfully request withdrawal of this rejection.

2. Claims 11, 12, 16-19, and 39-41 are also rejected under 35 U.S.C. § 102(b) as being anticipated by Yarovenko et al. *11/11/02 Office Action* at pp. 3-4. Applicants respectfully traverse this rejection.

In the present Office Action, the Examiner sustains the rejection because "composition is not relied upon the intended use." *Office Action* at p. 2.

Applicants respectfully disagree. Applicants arguments do not rest solely within an intended use argument but on the clear difference between the claimed composition and the compounds disclosed in the prior art. As previously stated, the Federal Circuit has articulated that a "composition" is not a compound but a mixture of substances.

*PIN/NIP, Inc. v. Platte Chemical Co.*, 304 F.3d 1235, 1244 (Fed. Cir. 2002). Thus, the present claims recite structural features not present in the cited art, which discloses only compounds. The mere disclosure of a compound is not sufficient to anticipate a composition, much less a reducing composition for permanent deformation of hair as claimed.

Even if, for the sake of argument, the Examiner has established a *prima facie* case of anticipation, the M.P.E.P. allows an applicant to rebut the *prima facie* case with "evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product." M.P.E.P. 2112.01. Applicants submit that one of ordinary skill in the art would readily appreciate that the pure compounds disclosed by Yarovenko would not be operable as a reducing composition to be applied to the hair, as it could damage the hair. One of ordinary skill in the art would appreciate that a reducing composition for the hair would include the reducing compound only in diluted form, as well as at least one other ingredient to render the composition suitable for the reducing composition.

Applicants respectfully submit that Yarovenko does not anticipate the invention as claimed because Yarovenko's compounds are not reducing compositions. Accordingly, Applicants respectfully request withdrawal of this rejection.

B. Shibanov

Claims 11-19 and 39-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shibanov et al. (DN 70:87599, CALUS, abstract of SU 229521).

11/11/02 Office Action at pp. 4-5. Applicants respectfully traverse this rejection.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

As with Yarovenko above, Shibarov is cited to show the disclosure of a single compound, which the Examiner believes is sufficient to anticipate the claimed compositions. *11/11/02 Office Action* at p. 2.

Applicants respectfully disagree. The claimed invention is directed to compositions, i.e., a mixture of substances. Shibarov does not teach or disclose compositions, but merely discloses single compounds. Moreover, Shibarov does not disclose reducing compositions for permanent deformation of hair as claimed. Thus, for the same reasons discussed above, Shibarov does not disclose each and every element of the claim, as is required for anticipation.

Accordingly, Applicants respectfully request withdrawal of this rejection.

#### IV. Rejection under 35 U.S.C. § 103

Claims 11-12, 16-42, and 100 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Amon (GB 1 201 601). *11/11/02 Office Action* at p. 6. According to the Examiner, Amon "teaches a reducing composition for hair waving or straightening containing aminoiminomethanesulfinic acid or a water-soluble salt thereof." *Id.*

To establish a *prima facie* case of obviousness, an Examiner must demonstrate that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference. See M.P.E.P. § 2143.

Claims 11-12, 16-42, and 100 do not encompass formamidinesulphinic acid. Amon, in contrast, fails to teach or disclose any other compound besides formamidinesulphinic acid as a reducing agent. All of the examples described by Amon

relate only to formulations containing formamidinesulphinic acid. Moreover Amon highlights the benefits of a composition containing formamidinesulphinic acid by noting several advantages:

- (a) eliminates "at least one step [enabling] a saving of time to be effected in the permanent waving of hair without undue expense";
- (b) leaves hair "in a silky manageable and revitalized condition";
- (c) "application of a hair conditioner such as lanolin or lanolin substituted creams can be dispensed with, thus effecting further labour saving and other operational costs"; and
- (d) "a synergistic effect is obtained by the use of 2,2-dithiobis-(N-alkyl amide of an aromatic carboxylic acid) ... in conjunction with one of the activating agents.

*Amon* at p. 3, lines 24-47. *Amon* as a whole teaches one of ordinary skill in the art the use and benefits of the only formamidinesulphinic acid as a reducing agent, and not of any other reducing agents, much less the N-substituted formamidinesulphinic acid derivatives of formula (I) as claimed. Thus, *Amon* does not provide the requisite suggestion or motivation to replace formamidinesulphinic acid with the claimed reducing agents.

Accordingly, Applicants respectfully request withdrawal of this rejection.

**V. Conclusion**

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, she is invited to call the undersigned at (202) 408-4173.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By: Mani Bant Reg. No. 52,516  
for Anthony C. Tridico  
Reg. No. 45,958

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FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com